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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/334,510	06/21/1999	KOICHI ABE	1232-4544	5401
27123	7590	11/04/2004	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			EBRAHIMI DEHKORDY, SAEID	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/334,510	ABE, KOICHI	
	Examiner	Art Unit	
	Saeid Ebrahimi-dehKordy	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-11, 17, 19, 20, 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-11, 17, 19, 20, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/28/2004 has been entered.

Response to Amendment

Applicant argues on page 10 lines 9-15 on the response filed on 3/5/04 that the Cotte et al does not disclose how scan software installed in a host computer is started. Examiner disagrees and points out Cotte et al, column 10 lines 34-40 where the insertion of the paper also causes a code to be sent over the cable to the input device software resident on the host 210 which triggers the host to read the serial port to which the cable 212 is coupled to receive the data coming in from the input device 214.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 5-11,17,19-20 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oida et al (U.S. Patent 5,987,186) in view of Cotte et al (U.S. Patent 5,499,108)

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Regarding claim 5, 19 and 22 Oida et al disclose: A scanning system comprising: a print device with a scanner function (please note column Fig.2 item 219, column 3 lines 58-65) which allows printing and scanning by selectively mounting a print head and a scan head on a head mounting portion (please note Fig.2 column 4 lines 33-37 where Oida et al teach the mounting of both print head and scan head selectively) wherein said print device includes a first detector configured to detect that said scan head is mounted on said head mounting portion (please note column 4 lines 33-38). However Oida et al do not disclose: and a second detector configured to detect an original to be scanned in the scanning; and an external computer which is connected to said print device to be able to communicate therewith, and comprises a scanner software for controlling scanning operation of print device, Wherein said print device communicates with said external computer to-start said scanner software when said first detector detects that said scan head is mounted on said head mounting portion, and to execute the scanning by said scan software when said second detector detects the original to be scanned in the scanning. On the other hand Cotte et al disclose: and a second detector configured to detect an original to be scanned in the scanning (please note Fig.12 item 222 the sensor, column 10 lines 28-31) and an external computer which is connected to said print device to be able to communicate therewith (please note Fig.12 item 210 the host or compute, column 10 lines 34-36) and comprises a scanner software for controlling scanning operation of print device (please note column 10 lines 35-39 where the software is in the host 210 to communicate with the printer) Wherein said print device communicates with said external computer to-start said

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scanner software (please note column 10 lines 28-39 where the insertion of the paper is also causes the code to be sent over the cable to the input device software resident in the host 210) when said first detector detects that said scan head is mounted on said head mounting portion (as disclosed in the Oida et al where the scan head selectively mounted) and to execute the scanning by said scan software when said second detector detects the original to be scanned in the scanning (please note column 10 lines 35-40). Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Oida et al's invention according to the teaching of Cotte et al, where Cotte et al in the same filed of endeavor teach the way the sensor or detectors in the sense the insertion of the original and trigger a signal which activates the software in host to start scanning for the purpose of making the scanning faster and more efficient.

Regarding claim 6 Cotte et al disclose: The system according to claim 5, wherein said print device is designed to send a scanner start signal to said external computer (please note column 10 lines 28-34) said scanner software comprises a detection module for detecting the scanner start signal (please note column 10 lines 28-38) said detection module along in said scanner software is running in a standby state in which said print device has not been started as a scanner and modules other than said detection modules in said scanner software are started when said detection module detects the scanner start signal (please note column 10 lines 28-38). However Cotte et al do not disclose: when said scan head is mounted on said head mounting portion. On the other hand Oida et al disclose: when said scan head is mounted on said head

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mounting portion (please note column 4 lines 33-37). Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Oida et al's invention according to the teaching of Cotte et al, where Cotte et al in the same filed of endeavor teach the way the sensor or detectors in the sense the insertion of the original and trigger a signal which activates the software in host to start scanning for the purpose of making the scanning faster and more efficient.

Regarding claim 7 Cotte et al disclose: The system according to claim 6, wherein when all the modules in said scanner software are running said detection module uses a sufficiently small work area of said external computer compared to other modules (please note column 10 lines 35-42).

Regarding claim 8 Oida et al disclose: The system according to claim 5, wherein said print head is an ink-jet print head (please note column 3 lines 57-65).

Regarding claim 11,20 and 23 Cotte et al disclose: A scanning system according to claim 5 wherein said external compute further comprises an application software which can edit an image scanned by said print device and said print device communicates with said external computer to transfer the read image to said application software (please note column 10 lines 35-40).

Regarding claim 9 Cotte et al disclose: The system according to claim 5, said scanner software further comprising a prescan selection module for selecting whether or not a prescan is made upon scanning the original and wherein when said scanner software is started and it is selected by said prescan selection module that the prescan

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is to be made an image of the original is prescanned and read into said scanner software. (please note column 10 lines 28-38).

Regarding claim 10 Kang discloses: The system according to claim 9, wherein said scanner software displays the pre-scanned and read image (please note column 10 lines 31-48).

Regarding claim 17 Cotte et al disclose: The system according to claim 11, wherein said scanner software comprises an application software run detection module for detecting whether or not said application software is running (please note column 10 lines 28-38).

Contact Information

- Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (703) 306-3487.

The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (703) 305-4863.

Any response to this action should be mailed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

Or faxed to:

(703) 872-9306, or (703) 308-9052 (for **formal** communications; please mark
"EXPEDITED PROCEDURE")

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Or:

(703) 306-5406 (for **informal** or **draft** communications, please label "PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 305-4750.

Saeid Ebrahimi-Dehkordy

Patent Examiner

Group Art Unit 2626

October 29, 2004



KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER

KA Williams

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